



OHIM

the year in review

It has been a hectic year in Alicante. While continuing its core activities, OHIM came under new leadership, commenced internal restructuring and found itself at the heart of debate on the future of the European trademark system. In this article *WTR* identifies the top filers and canvasses opinion on OHIM's performance and the big issues of the day



For the past five years, the October/November issue of *WTR* has aimed a spotlight at the Office for Harmonisation in the Internal Market (OHIM). This year, for the first time, *WTR*'s analysis focuses on an agency headed up not by Wubbo de Boer, but rather by his successor Antonio Campinos, who commenced his term as president on October 1 2010.

Campinos' first speech as president came towards the end of October last year. Addressing members of German brand federation Markenverband, he hit all the right targets, stressing the importance of tackling the backlog, emphasising quality as a continued focus and identifying the need for "fruitful cooperation with the national intellectual property offices in the EU", as well as with all other stakeholders.

But his speech also indicated a desire to embrace change proactively, as he welcomed an exploration of OHIM's potential role in enforcement activities – a stark contrast to his predecessor's stance. Campinos stated: "We must look closely at the added value that we can bring to initiatives such as the Commission's Observatory on Counterfeiting. Over the coming years we have to roll out an ambitious programme of cooperation which should, among other things, include the fight against counterfeiting as recommended by the European Commission in the recent communication on the enforcement of IP rights in the internal market."

Following publication of the Max Planck Institute's Study on the Overall Functioning of the European Trademark System in March 2011, and the subsequent release of the European Commission's blueprint for IP rights (see page 71), OHIM's potential anti-counterfeiting role is just one topic of current debate. And when these developments are viewed alongside the ongoing internal restructuring at OHIM, it becomes clear that Campinos' first year in the hot seat has certainly been a busy one.

All change

In May 2011 OHIM released initial details of its new strategic plan, setting out three overall objectives:

- to build a strong, vibrant organisation;
- to improve quality and optimise the timeline of operations; and
- to promote convergence of practice.

To this end, six lines of action were identified:

- human resources reform and cultural renewal;
- simplification and modernisation of information systems (with the aim of streamlining a system within which 84 IT systems and 57 different databases currently coexist);
- expansion and optimisation of the working environment (which includes plans to extend the current OHIM building in Alicante and unite the whole organisation under one roof);
- establishment of the IP Academy and knowledge repository (which OHIM states is designed to "cascade knowledge among staff, as well as external sectors interested in IP");
- improvement and broadening of quality; and
- development of the European network (to facilitate international cooperation).

The announcement followed an extensive consultation period and reflects the position that OHIM now finds itself in, rather than Campinos' own agenda for the agency, according to Tove Graulund, MARQUES representative and principal of Graulund IP Services: "From the perspective of being an observer at the Administrative Board, there are differences under the new president, but this is natural and is also partly a result of progress. The organisation has

been very serious about catching up on the backlog, and focused efforts there. Now it is time to increase the focus on quality. With the new management we are essentially moving on – OHIM is evolving and is also now able to take on the issue of harmonisation, which is, after all, part of its name."

To help achieve the objectives set out in the plan, details of an internal reorganisation were unveiled, creating five main departments (operations, operations support, international cooperation and legal affairs, resources and infrastructure), accompanied by five horizontal services (internal audit, the IP Academy, communications, economics and statistics, and portfolio and quality management).

Providing a progress update on the changes, Campinos told *WTR*: "The draft strategic plan has been widely circulated among stakeholders and we have made an audio-visual presentation available on our website. We are still working on a breakdown of some of the more detailed objectives – we call it a scorecard – which will make it easier to see what the achievements are. The final plan will be published in the autumn, when we have consulted on these changes; but in the meantime we are already in phase two of the plan, which is the implementation part. The new organisational structure, with just five departments supported by a number of horizontal services, is designed to avoid 'silos' and encourage collaborative working." Importantly for users, Campinos is keen to stress that it will be business as usual while the changes take place: "As for the possibility of any interruptions of service while it beds in, that is certainly not part of the plan!"

The OHIM reshuffle was initially announced to the public online and word seems to have quickly reached the trademark community. More than four-fifths of respondents to *WTR*'s survey were aware of the plans, with a range of sources cited (including the OHIM website, industry publications and blogs, associations such as the European Communities Trademark Association and MARQUES, and interaction with OHIM staff).

With regard to how the changes were communicated, Pablo López-Ronda, manager of the Community trademark unit at Clarke, Modet & Co in Alicante, suggests: "We were made aware of the new organisational structure by means of OHIM's database, as well as different IP blogs; but it would be helpful if OHIM directly informed practitioners – by fax or email – of this new structure and even provided the direct contact details of the person in charge of each service or department."

Working together

The reorganisation was announced two months after the Max Planck Institute made its Study on the Overall Functioning of the European Trademark System publicly available.

Survey methodology

In July 2011 *WTR* sent out a survey to the 40 leading agent filers of Community trademarks listed in the table on page 32. Key representatives from the firms were asked 30 questions on a range of topics, designed to explore current issues surrounding the European trademark regime and assess OHIM's performance over the past 12 months. *WTR* collated and analysed the responses, and the key results are set out in the text and accompanying graphics.

In order to guarantee candid answers, respondents were offered the option of having their comments unaccredited when used in the article.

Methodology for filing tables

OHIM data lists the Community trademark filings originating from individual offices (with each designated a unique Community trademark representative code). This means that a single firm can have multiple entries, in multiple countries, under the same firm name (because the named firm filed via a range of individual offices, each designated its own unique Community trademark representative code). To obtain an alternative perspective on the market, *WTR* compiled the tables in this article, using data kindly provided by OHIM, by adding the filings of all the offices (filing 25 or more Community trademarks) of each named firm. *WTR* considered only applications filed by law firms or patent and trademark agents. Further, having compiled the list according to overall filings by firm name, we then compiled the top 10 country lists according to each firm's country of origin; so, for instance, Hogan Lovells appears in the UK table, not the Spanish table. While every care has been taken to guarantee that all relevant figures were considered, *WTR* accepts no responsibility for any errors in the tables.

At the heart of the research project is the theme of increased cooperation between national offices and OHIM, with proposals to develop common guidelines for examination and common rules on classifications for goods and services. The study notes: "Ultimately, the national offices contribute as the competent authorities to maintain the national trademark systems and thus the overall functioning of the European trademark system. The coexistence between the supranational Community trademark (CTM) system and the national trademark systems is one of the basic principles of European trademark law. This principle implies the existence of national systems and national offices. Without well-functioning national offices, the present system would no longer exist and European trademark law would have to be fundamentally revised."

Of course, this is not a new suggestion, and Cooperation Fund projects have been established to work towards the goal of common systems and processes, thus creating closer ties between national offices and OHIM. For instance, OHIM is currently working with a number of national offices – including in the Czech Republic, France, Ireland, Portugal, Romania, Greece and the United Kingdom – to compare entries held nationally with those in the Community Trademark Register. The project will involve establishing links between entries in the national and Community databases and making the information accessible online.

However, the combination of the Max Planck study, the commission's IP blueprint (of which more later) and Campinos' stated goal of creating a converged European trademark system has given the goal of harmonisation renewed momentum and, importantly, set the wheels in motion.

In particular, the study laid out a number of proposals as to how this might be achieved. One suggestion was that national offices could be involved in the examination of CTM applications: "In the course of examining individual trademarks, OHIM and national offices could cooperate by putting new applications on a common internet-based platform for a limited period of time allowing participating offices to raise objections, which would become part of the examination in the respective office." The study added that national offices could be remunerated for the contribution they make.

Speaking to *WTR* after publication of the study, co-author

Figure 1. How would you rate OHIM's performance over the past 12 months?



Figure 2. How would you rate OHIM's handling of CTM applications over the past 12 months?



Figure 3. In general terms, how would you rate OHIM's performance in terms of CTM opposition action over the past 12 months? Has it improved over the previous year?



Alexander von Mühlendahl said: “Involving national offices in examination would improve consistency across the board. I personally believe this. Imagine if you established internet-based platforms on which national offices and OHIM could pose questionable cases for, say, one day, five days or 10 days, and receive input from the other offices.”

When questioned on this particular proposal, the majority of filers that WTR contacted were in favour (59%). Frustration was voiced that in some instances, a national office would reject a mark while OHIM would accept it: “It would be nice if national offices would handle marks the same way as OHIM for consistency.”

While the goal of consistency was welcomed, there was also a feeling that it may be hard won. Fabrizio de Benedetti, managing partner at Società Italiana Brevetti SpA, warns: “It is a very delicate issue which requires much more study and analysis. To guarantee consistency when the work is done by examiners working in different entities and within different legislative systems does not appear easily feasible.”

Yet it remains an objective to strive for, with the balance between the CTM and national systems, as well as harmonisation of practice, commonly cited as the improvements which would be of greatest benefit to both users and other stakeholders. Simone Verducci-Galletti, an associate at Bugnion SpA, concludes: “I think that any rule providing better links between the national systems and the CTM regime will be very welcome. This would make the clearance process easier and give everyone guidance in their filing strategies.”

And Campinos echoes this sentiment. On the prospect of shared examinations, he says: “We have no taboos, particularly when it comes to increasing ties with member states. Our vision is to create an EU trademark and design network that will, in partnership, give renewed impetus to the process of convergence. We are already converging in practice on absolute grounds and on relative grounds, and are tackling other issues through the convergence programme. At the minute, we have an important and often overlooked mechanism for exchanging practice between offices – the secondment of staff from other offices to work with us.

“Last year, we had 36 of these national experts and we are keen both to continue this and also to look at the possibility of OHIM staff working in national offices or with international partners such as the World Intellectual Property Organisation (WIPO) or the European Patent Office. In the end, we can certainly try to be more consistent and to follow similar decision paths and practices, but I don’t think we can envisage handing over our responsibility for

Figure 4. In general terms, how would you rate OHIM’s performance in terms of CTM appeals over the past 12 months?



Figure 5. In general terms, how would you rate OHIM’s performance in terms of handling RCD applications over the past 12 months?



“ In July, OHIM launched an International Convergence Programme. Campinos says, ‘The practices to be reviewed will be chosen by agreement. Both national offices and user associations are taking part in the process and, having been consulted on the programme, have made valuable contributions with regard to the areas to be chosen for convergence’ ”

Figure 6. Would you like to see a cut in the CTM renewal fee?

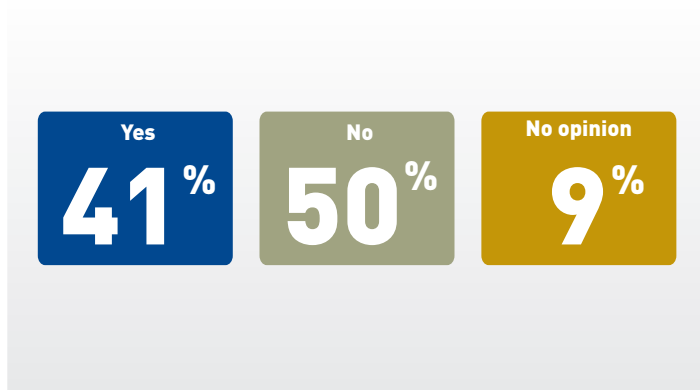


Figure 7. Would you like to see a cut in the CTM opposition fee?

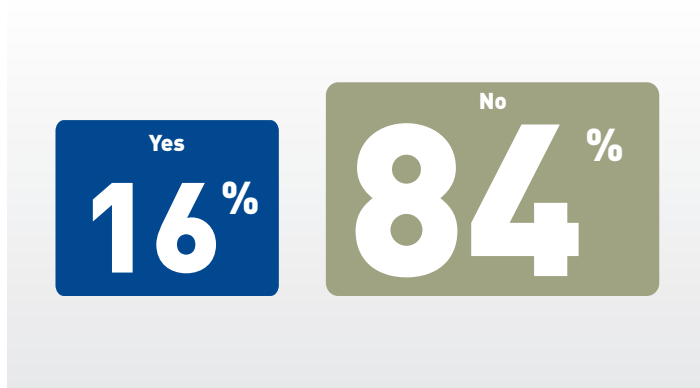
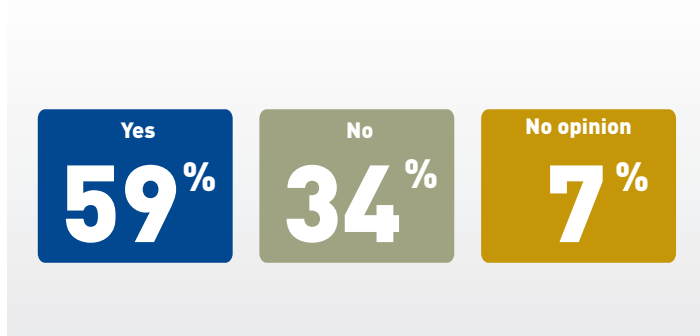


Figure 8. The recently published European trademark study suggested national office examiners could take on CTM examinations. Do you support this proposal?



making examination decisions to anyone else.”

Converging practice

While certain aspects of convergence may require legislation, as OHIM’s president mentions, the agency launched an International Convergence Programme in July to tackle areas where legislative change is not needed – reaching common ground on a number of areas where IP offices in the European Union have different practices.

OHIM notes that “work on the harmonisation of classification of goods and services is already underway and this has been adopted as the first project in the new Convergence Programme. A kick-off meeting on a second project, to try and reach consensus on the treatment of class headings in trademarks, was attended by representatives from 21 offices and WIPO. The philosophy of the convergence programme is that convergence will emerge not as a result of force, but by getting together round the table and addressing shared concerns in the interests of users”.

The benefits for users should include more effective and efficient protection from trademark and design registration systems, cost savings “and greater legal certainty, since there will be fewer situations in which similar cases are treated in a dissimilar manner in different offices”.

Inge Buffolo, OHIM’s programme manager for the International Convergence Programme, explains: “Different practices have developed for different reasons – because of the traditions in some offices or as a result of decisions of the national courts, which they rely on. Our intention is to facilitate the process of bringing everyone together again. This will not only be for the benefit of users; it will also bring big advantages to the offices.”

To make the Convergence Programme workable, OHIM has proposed that a total of five projects, including the harmonisation of goods and services and class headings projects, be targeted. All projects are expected to be fully launched by early next year.

Campinos explains: “The practices to be reviewed will be chosen by agreement. Both national offices and user associations are taking part in the process and, having been consulted on the programme, have made valuable contributions with regard to the areas to be chosen for convergence. We want this to be a very inclusive process. The convergence programme is for the benefit of national offices and users, and both are being fully involved in the definition of it.

“For example, with regard to the class heading project, the first meeting with national offices took place in Alicante at the beginning of July, with representatives from 21 member states and WIPO. Another meeting on the same issue is scheduled for the end of September. It is very important for people to sit down face to face at the beginning, but afterwards a lot of work can be done by video conference, email or using Wikis. Nevertheless, we will have regular meetings on each of the specific topics to be tackled, certainly until the new practice is defined. In the implementation phase, a lot of the work will be done in the individual national offices.”

With regard to how the final five projects will be actualised, he adds: “It is important that the process is open and transparent. We have already received a number of suggestions from national offices and user associations, and are consulting on the final choice. There will probably be an announcement in September or October.

“As for the limit of five projects, that’s been suggested to make the process achievable and these five projects will cover the most significant areas where convergence will be most beneficial and the impact for users and national offices will be most apparent and tangible.”

Figure 9. One issue that proved divisive when user groups discussed the study was the question of whether clutter was an issue on the CTM register. Do you feel the register is currently impaired by congestion or not?

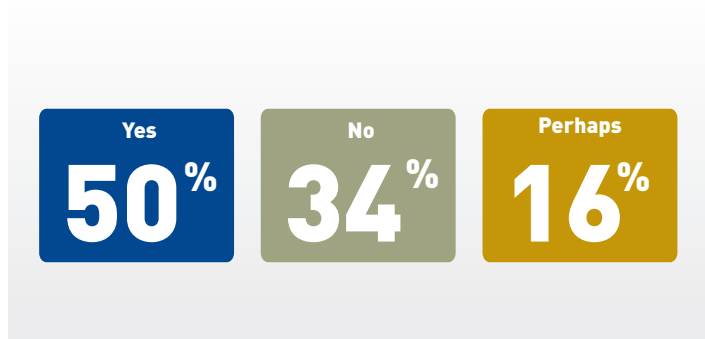


Figure 10. OHIM president Antonio Campinos has expressed an interest in OHIM taking on a wider role as a European IP office (excluding patents). Would you support such a development?

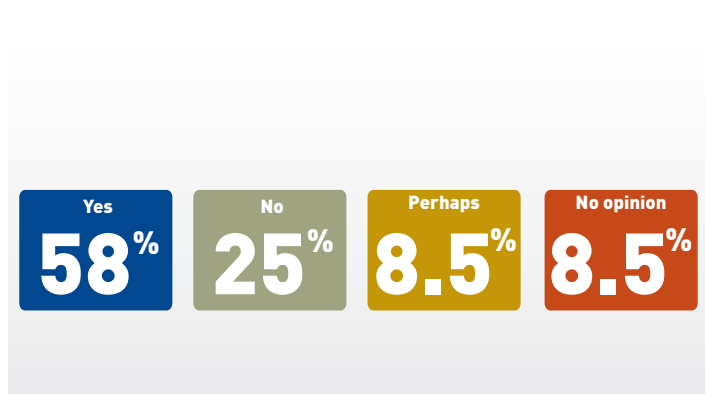
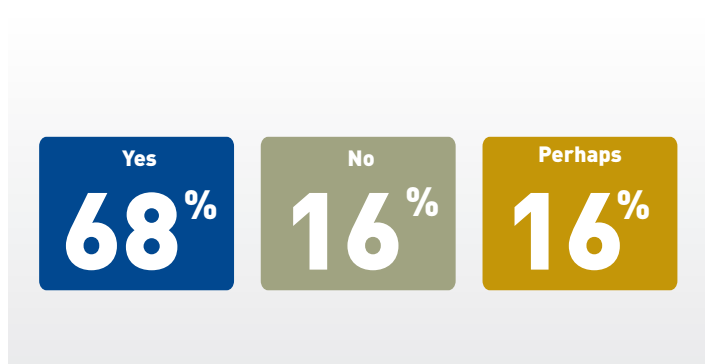


Figure 11. The European Commission has proposed that the European Observatory on Counterfeiting and Piracy be entrusted to OHIM. Do you support this proposal?



Renewed positivity

In May, Campinos told *WTR* that users are more interested in having a system that works and that offers consistency and value for money, than in the nature of the specific practices adopted: “They really don’t care about political differences. What matters is not the minutiae of practice or arguments about which system is better, but rather ensuring that the same approach is taken. This is what users want.”

However, Graulund suggests that users are in fact mindful of the processes which will be adopted, and stresses it is vital that this be kept at the forefront of discussions, no matter how long they take: “It may have been put like that, but to some extent this is something you will say when you become desperate. If you sit and hear people negotiate over the minutiae of wording of articles, and where a full stop or comma goes, then at some point you just say, ‘Come on, get on with it – we’ll work with what you give us.’ So people may be saying this, but it is only when you get tired that you feel like that. Of course we would like to see best practice established and things done the right way.”

As to how this can be achieved, Graulund agrees that the convergence programme is the right forum: “This can only be done in an environment where people trust each other and work together, and the convergence programme does provide a forum to discuss specific topics. This is exactly what we want. It may take time, but that is fine, as achieving the right result is important.”

Encouragingly for users, Graulund has noted a renewed enthusiasm in the relationship between OHIM and national offices: “The tensions that existed between OHIM and the national offices seem to have disappeared – everyone is positive and willing to hear what the new management want to do. It’s like the 100-day honeymoon period. This really came through at the last board meeting – everyone just seemed positive and excited.”

An expanded role

Following publication of the Max Planck study, the European Commission announced proposals that would expand OHIM’s role further. In its blueprint for IP rights, the commission proposed that the European Observatory on Counterfeiting and Piracy be entrusted to the office. The move would see OHIM working to improve understanding of the scope and impact of IP rights infringements, enhance the expertise of those involved in IP enforcement, strengthen available tools to prevent and combat counterfeiting and piracy, and foster international cooperation between offices.

The proposal was welcomed by those representative filers polled, with 68% favouring such a move (the one caveat being that OHIM continue to attend to its registration duties). In the plus column, filers cited the benefits of having one interlocutor on these matters and the fact that such activities require money and investment – resources that OHIM is not scarce of.

López-Ronda adds: “OHIM’s control and leadership of this area of IP – namely enforcement – would probably lead to an easier dissemination of information among consumers and market actors, and thus to increased public awareness. Furthermore, it could help accelerate the harmonisation of proceedings among the different European authorities (both national and supranational).”

But Graulund suggests that more detail is needed before a definitive stance can be taken: “It has been said that there is widespread support from users, and I don’t think that is strictly true as it is too soon – not enough detail is known. It helps that the president is talking and explaining to people, but as an organisation, we still feel it is still a bit fuzzy in terms of exactly what OHIM will

Top representative filers of CTM applications from June 1 2010 to May 31 2011

Position	Representative name	Representative country of origin	CTM filings
1	Bureau Gevers	BE	931
2	Novagraaf Nederland BV	NL	756
3	Marks & Clerk LLP	GB	744
4	Clarke, Modet Y Cia SL	ES	551
5	Jacobacci & Partners SPA	IT	516
6	Boehmert & Boehmert	DE	488
7	Bugnion SPA	IT	463
8	Elzaburu, SLP	ES	461
9	Barzano & Zanardo	IT	449
10	Hogan Lovells	GB	448
11	Ungria Lopez	ES	441
12	Forrester Ketley & Co	GB	426
13	Perani & Partners SPA	IT	417
14	Cabinet Germain & Maureau	FR	398
15	J. Isern Patentes Y Marcas	ES	382
16	Frkelly IE		368
17	Harrison Goddard Foote	GB	365
18	Grunecker, Kinkeldey, Stockmair & Schwanhausser	DE	363
19	D Young & Co LLP	GB	354
20	Zacco Netherlands BV	NL	352
21	Field Fisher Waterhouse LLP	GB	349
22	Boulton Wade Tennant	GB	331
23	Taylor Wessing	GB	323
24	Jeffrey Parker and Company	GB	321
25	Murgitroyd & Company	GB	317
26	Urquhart-Dykes & Lord LLP	GB	306
27	Herrero & Asociados	ES	305
28	RGC Jenkins & Co	GB	299
29	Kilburn & Strode LLP	GB	296
30	Pons Patentes Y Marcas Internacional, SL	ES	295
31	Modiano IT		276
32	Albihns.Zacco AB	SE	270
33	Withers & Rogers LLP	GB	258
34	Friedrich Graf Von Westphalen & Partner	DE	256
35	Gill Jennings & Every LLP	GB	253
36	Barker Brettell Llp	GB	248
37	Mewburn Ellis LLP	GB	243
38	Novagraaf France	FR	242
39	Bureau Casalonga & Josse	FR	241
39	Societa Italiana Brevetti SPA	IT	241

Top representative filers of CTM applications from Italy from June 1 2010 to May 31 2011

Position	Representative name	CTM filings
1	Jacobacci & Partners SPA	516
2	Bugnion SPA	463
3	Barzano & Zanardo	449
4	Perani & Partners SPA	417
5	Modiano	276
6	Societa Italiana Brevetti SPA	241
7	Studio Torta SRL	193
8	Giambrocono & C. SPA	187
9	Dott Prof Franco Cicogna	166
10	Notarbartolo & Gervasi	148

Top representative filers of CTM applications from Spain from June 1 2010 to May 31 2011

Position	Representative name	CTM filings
1	Clarke, Modet Y Cia, SL	551
2	Elzaburu SLP	461
3	Ungria Lopez	441
4	J Isern Patentes Y Marcas	382
5	Herrero & Asociados	305
6	Pons Patentes Y Marcas Internacional, SL	295
7	Abril Abogados	213
7	Pons Consultores De Propiedad Industrial, SA	213
9	Curell Sunol SLP	188
10	Udapi & Asociados	161

be doing. We have no doubts about the good intentions, but we would like close coordination with the user organisations and those who can input into the plans. And if they end up doing a good job, we certainly won't be complaining."

In May, Campinos expressed his enthusiasm for the challenge, going further and suggesting that OHIM could take on the wider role of European IP office: "Does it not make sense to have a European IP office? While patents are already catered for, does it not make sense to have one agency overseeing all the remaining IP rights? We are certainly ready to take on such a task if asked. Internally and externally, it makes a lot of sense to a lot of people. As long as we don't lose our focus on the registration function, cost efficiency and quality, and achieve our core aims, could we not do more?"

Again, this suggestion was positively received by a majority of survey respondents (58%), with just one-quarter viewing it negatively (17% had no opinion).

Those not keen on the idea felt that the agency should instead focus on continuing improvements in existing activities. There was also disagreement about the remit of the potential role. One respondent argued: "It makes no sense if patents are excluded, and since patents must be excluded, it makes no sense at all." By contrast,

Lidy-Anne Jeswiet, head of the trademark practice at Gevers Belgium, suggests that an even more limited mandate would

Top representative filers of CTM applications from Benelux from June 1 2010 to May 31 2011

Position	Representative name	Country of origin	CTM filings
1	Bureau Gevers	BE	931
2	Novagraaf Nederland BV	NL	756
3	Zacco Netherlands BV	NL	352
4	Merkenbureau Knijff & Partners BV	NL	233
5	Elzas Noordzij BV	NL	214
6	MERK-ECHT BV	NL	209
7	Office Ernest T Freylinger SA	LU	178
8	Nederlandsch NL Octrooibureau		174
9	Vereenigde NL		169
10	Algemeen Octrooi-En Merkenbureau	NL	123

actually be of benefit: “I agree with the idea, but not just excluding patents, but also excluding copyright. Anything that has to do with names and signs would be okay, because it would be good if, for example, geographical indications (GIs) were centralised and harmonised.”

OHIM assuming responsibility for a GI register is something that Graulund would also welcome: “We would certainly not be against OHIM taking responsibility for running a GI register. They do this sort of task very well and, as someone with a background in the agricultural sector, I think it would be good if OHIM took on responsibility for keeping a registry of all the EU GIs. It is really very untransparent at present, and when you do a search it is a challenge – some people know where to look and others don’t. If OHIM could step in and create an accessible way to pre-search GIs, this would be perfect – imagine if the GI register were part of TMview!”

“Our longer-term goal would be to have fairer examinations of GIs, as currently a brand owner cannot object to the registration of a GI. It is a member state issue and a member state must object – there is no private interest voice or opposition process. I think that ‘first in time, first in right’ needs to be respected, but such a development is quite far off.”

Overall, then, representative filers do seem ready to embrace change, with one suggesting that as long as other practices continue to improve, an expanded role for OHIM “could be a way to solve the surplus problem”.

López-Ronda adds: “We are confident that, should OHIM adopt a

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The genuine use issue continues to divide

When considering the convergence of national and transnational systems, the elephant in the room remains the issue of overlap – in this instance, the specific question of what constitutes genuine use of a Community trademark. In last year’s OHIM focus, this debate was a dominant issue and, while we have received further insights into stakeholders’ views on the issue over the past 12 months, there is still some way to go until consensus is reached.

On this, the EU trademark study supported an interpretation of the ‘genuine use’ requirement for Community trademarks which disregarded political frontiers, with the caveat that individual cases should be left to the courts: “The requirements for ‘genuine use’ referred to in Article 15 of the [EU Community Trademark Regulation] must be assessed on a case-by-case basis taking into account the criteria developed by the ECJ. The extent of use, including the territorial extent, is one of the criteria that are relevant in determining the genuineness. Therefore, there is no reason or room for requiring that a CTM in order to be maintained or enforced necessarily has to be used in more than one member state.”

While it disregarded national boundaries as a criterion, acknowledging that the community is larger than it was two decades ago, the study did introduce the concept of remoteness: “The registration and use of subsequent national trademarks in a member state remote from the part of the community where a conflicting earlier CTM which has been registered for a period of at least 15 years, was used should be allowed provided that the later mark was applied for in good faith. Such registrations should coexist with the earlier CTM which continues to be valid and enforceable and may also be used in that member state.”

As has characterised the debate thus far, agreement on what constitutes genuine use was not apparent in *WTR*’s survey of filers. On the one hand, there is recognition that Community trademarks, as stated by Graf von Westphalen’s Kristofer Bott, “relate to markets, not to national boundaries, and genuine use should be related to that”.

Lidy-Anne Jeswiet, head of the trademark practice at Gevers Belgium, adds: “The notion of Member State should be abandoned in a uniform EU. The decision on genuine use must be a question of facts, and all circumstances have to be taken into account: the nature of the products/services, the size of the trademark holder, intensity of use, length of time, etc.”

However, the question of whether use in one jurisdiction is enough to prevent use across the European market persists. Verducci-Galletti ponders: “It is a difficult question. I understand OHIM’s position, but it is also to be considered that many things changed after the enlargement of the Union. I believe that this issue is directly linked to creating a correct balance between national trademark systems and the CTM system. National systems have reason to exist if they are properly used. The same applies to the CTM system. A local project should be protected by means of a ‘local mark’, while a European Union project should be protected by a CTM.”

Elsewhere, a spokesperson for Modiano & Partners told *WTR*: “The concept of use in two to three large member states, or the equivalent population ratio, should be applied.”

Ultimately, though, clarity is the real goal: “The principal need is to have a definitive criterion in this matter,” concluded one agent.

wider role, this would encourage European competitiveness and innovation through closer cooperation between the different European authorities.”

But whatever the future role of OHIM, for users the here and now is all-important, so in addition to polling the top filers on some of the burning issues of the day, *WTR* asked for views on current practices, procedures and tools.

User satisfaction

In considering the agency’s overall performance, the picture has improved since last year’s survey. In 2010, 91% of respondents rated

the office’s performance as satisfactory (9% unsatisfactory). This year, just 67% responded that it was satisfactory; the drop was due to users instead giving OHIM a more positive rating, with 16% stating that its performance was good and 9% very good.

The reasons for this positive shift were numerous, with filers variously citing speed in opposition division decisions, reduced delays in absolute grounds examinations and prosecution times as key factors.

Campinos agrees: “We have got faster in most areas, and speed continues to be an important quality criterion on which we are judged by users. Our current target for oppositions (excluding suspended files) is to notify the decision within 10 weeks and we are achieving that in 88% of cases at present, which is still below our target of 99%. That’s a considerable improvement on the past – in 2009 we were achieving this performance standard in just 10% of cases.”

Where there were gripes, these centred on communication and difficulties in reaching examiners (one representative filer had the impression that they are “reduced to mere ‘numbers’ – there are no names mentioned on the documents anymore”).

When this is put to Campinos, he explains: “We have already taken some steps to improve matters by reactivating the contact points and the phone numbers common to various examiners, especially for calls relating to the files, and are working on additional measures such as increased cooperation between the information centre and the operations department. Regarding access to examiners, their names appear on most communications of the office and should always appear on objections and decisions. We are revising the templates so that the phone number of the examiner

“In considering overall performance, the picture has improved since last year’s survey, with users citing reduced delays in absolute grounds examinations and prosecution times”

Top representative filers of CTM applications from in the United Kingdom from June 1 2010 to May 31 2011

Position	Representative name	CTM filings
1	Marks & Clerk LLP	744
2	Hogan Lovells	448
3	Forrester Ketley & Co.	426
4	Harrison Goddard Foote	365
5	D Young & Co LLP	354
6	Field Fisher Waterhouse LLP	349
7	Boult Wade Tennant	331
8	Taylor Wessing	323
9	Jeffrey Parker and Company	321
10	Murgitroyd & Company	317

Top representative filers from other EU jurisdictions from June 1 2010 to May 31 2011

Position	Representative name	Country of origin	CTM filings
1	MAQS Law Firm	DK	134
1	Advokataktieselskab		
1	Patent Agency Kaosaar & Co	EE	50
1	Heinonen & Co	FL	134
1	Vayanos Kostopoulos Law Firm	GR	25
1	Georg Pintz & Partners LLC	HU	33
1	FR Kelly	IE	368
1	Kaspex Baltic	LV	39
1	Kondrat Law and Patent Office	PL	54
1	J. Pereira Da Cruz, SA	PT	124
1	S.C. Weizmann Ariana & Partners Agentie De Proprietate Intellectuala SRL	RO	46
1	Albihns.Zacco AB	SE	270

Fees and clutter

One issue which became a topic of discussion when user groups gathered to discuss the European trademark study was the question of clutter on the Community Trademark Register.

The Max Planck Institute study reached no conclusions on the issue, stating: "There is no sustainable documentation showing that access to trademarks is substantially impaired by congestion of registers. On the other hand, it would equally be unwise to contend that the features of the present system which tend to invite a certain amount of cluttering are not giving rise to any problems at all, and will not do so in the future."

Speaking after the gathering, Christina Sleszynska, the International Trademark Association's (INTA) European representative, reported that "there seemed to be agreement that no one had yet been able to actually 'see' or 'find' the problem". Opposing views were therefore aired before the European Commission – mirroring, says Sleszynska, "INTA's own differing opinions on these questions within its committees".

When *WTR* polled the top Community trademark filers for this article, a split in opinion also emerged. When asked whether they felt that the register was currently impaired by congestion, exactly half answered in the affirmative, while over one-third [34%] felt that it was not and 16% were unsure.

The study did put forward one proposal that could have an impact on potential clutter: "the introduction of fees which will make claiming additional classes more expensive than today." This would seem to address the concern of many in the 'yes' camp, who feel that clutter is inevitable under a system that allows filers to designate up to three classes for the same application fee. The argument is that filers will claim protection for classes they will not use or need, merely because it is free. Lidy-Anne Jeswiet, head of the trademark practice at Gevers Belgium, explains: "While one might say the register is impaired by congestion, it is not because of the number of registrations. Rather, it is due to the number of classes and goods/services claimed per registration."

For some, congestion is an inevitable problem given that brand owners from many EU countries are "using this more and more instead of their national registration, in addition to all the non EU members for whom it is easy to get a Europe-wide registration". However, Elzaburu's Ramón Cañizares argues that, even if an issue, "cancellation actions based on non use against a Community trademark are very easy", thereby reducing the restrictions placed on businesses.

The issue of clutter is intrinsically linked to that of fee levels, as noted. Yet there seems broad acceptance of the current level of fees, particularly in terms of oppositions. When polled, 84% of responding users would oppose a cut in opposition fees. Simone Verducci-Galletti, an associate at Bugnion SpA, explains: "Opposition fees are already lower than in other countries, for instance in Benelux. The percentage of oppositions is very high and many of these oppositions are not well founded. Any cut in opposition fees may serve as an incentive for the filing of more oppositions."

But on Community trademark renewal fees, opinions were divided – exactly half stated that they would not like to see a cut in renewal fees, while 41% were in favour of a reduction and 9% were unsure.

Arguing for a cut, Arlette Molenaar, managing director of Zacco Netherlands, stated: "I always think a new registration should be more expensive than a renewal, which takes less time for OHIM to process."

In contrast, Verducci-Galletti counters: "The register is already crowded enough. Searching marks is always difficult and a cut in the renewal fee would probably mean that marks which are not really of interest to owners will be renewed purely because of the low cost of doing so."

As a solution, one proposal was that "the fee for renewal could be lower if we developed a system whereby proof of use or an affidavit of use is required".

Top representative filers of CTM applications from Germany from June 1 2010 to May 31 2011

Position	Representative name	CTM filings
1	Boehmert & Boehmert	488
2	Grunecker, Kinkeldey, Stockmair & Schwanhausser	363
3	Friedrich Graf Von Westphalen & Partner	256
4	Mitscherlich & Partner	188
5	Meissner, Bolte & Partner	182
6	Cohausz & Florack Patent- Und Rechtsanwalte Partnerschaftsgesellschaft	179
7	Lorenz Seidler Gossel	153
8	Hoffmann * Eitle	137
9	Harmsen & Utescher	130
10	Wuesthoff & Wuesthoff	128

will be systematically included in correspondence from the operations department or operations support department. While phoning the examiner may not always be the right solution for customers, it is not our policy to close off or discourage this possibility. Nevertheless, we do need to strike the right balance between providing access to examiners and allowing them to get on with the job of delivering decisions on time. This may mean that we need to work harder on providing alternative sources of information."

Staying with access to information, a number of filers mentioned the possibility of obtaining information by phone as an area for improvement. Campinos confirms that OHIM recognises the importance of this interface: "The information centre is a very important contact point with customers and we generally receive favourable feedback on the quality of its work. If there are problems with access, first of all, we need to look at the organisation of the work in the information centre and what tools they have to help them. We also need to see whether we can simplify procedures or involve the rest of OHIM in providing the first-class response that our customers need.

"Having more staff is not always the best solution, but if our analysis indicates that there is a need for more, we will take action. We recognise that you only get one opportunity to make a good first impression."

Other general issues cited by users included problems with MyPage (one filer explained: "We have had to establish a double-

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check process because there are some communications that we never received but which seem to be on the system”), and the refusal of recordal of changes requests, when refusals are not necessarily well founded.

Meeting published objectives

Drilling down, OHIM’s handling of CTM applications over the past 12 months was again viewed positively – 8% rated this as very good, 34% good and 58% satisfactory. Again, the speed of the process came in for high praise.

Campinos comments: “Almost all straightforward trademark applications are published within 10 weeks and registered within 25 weeks at present, which is in line with our current published objectives.” This has been achieved at “at a time when application levels are up. We received around 52,600 during the first six months of the year, including international applications, and on current trends the office expects about 107,000 applications in 2011 – close to 10% more than in the previous year”.

Potential areas for attention include consistency in absolute grounds for refusal examinations, as well as the need for deeper staff training. Arlette Molenaar, managing director of Zacco Netherlands, suggests: “One improvement would be knowledge of rules and procedures so that we do not have to consistently check whether what is said and done is correct.”

Opposition actions were a source of some concern among respondents, with nearly one-fifth (17%) rating OHIM’s performance

in this area as unsatisfactory (the same number as rated it as good). Although speeds have improved, a number of respondents questioned the quality of decisions. “Decisions often appear to be sloppy, if not mere exercises in cutting and pasting,” laments Fabrizio de Benedetti, managing partner at Società Italiana Brevetti SpA. “Use of the database for comparison of goods and services will further deprive opposition of its real purpose, which is that of carefully analysing the likelihood of confusion in the specific case at issue.”

On this point Campinos insists that the database plays a supporting role in decision making, rather than being the deciding factor: “A database can help support good decision making, but it can’t replace the role of the examiner. To put it another way, if the office has already made a certain decision in very similar circumstances on hundreds of occasions, this is useful information. However, it doesn’t prevent the examiner from saying, ‘This time it’s different.’ We then need to make sure that this is a well-reasoned decision and that the information is passed on to other examiners.”

To encourage proper decision making, one suggestion was to increase staff training in oppositions, “as they are currently making mistakes and we have to tell them that they are and make an objection in every instance”. Lidy-Anne Jeswiet, head of the trademark practice at Gevers Belgium, shares this frustration: “We had cases where oppositions were ignored and the trademark was registered. We then had to attract OHIM’s attention to the fact that we had submitted the oppositions. The situation has been redressed on each occasion, but it requires a lot of correspondence

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Top representative filers of CTM applications from France from June 1 2010 to May 31 2011

Position	Representative name	CTM filings
1	Cabinet Germain & Maureau	398
2	Novagraaf France	242
3	Bureau Casalonga & Josse	241
4	Cabinet Plasseraud	142
5	Cabinet Beau De Lomenie	124
5	T Mark Conseils	124
7	Cabinet Lavoix	123
7	Inlex IP Expertise	123
9	Cabinet Regimbeau	112
10	Pro-Mark 110	

and, of course, creates an unpleasant feeling and uncertainty for both parties.”

As with OHIM’s overall performance, this year’s survey tracks an improvement in its handling of appeals over the past 12 months. Nine percent of respondents rated its performance as very good, while 36% stated it was good (30% in 2010) and 55% satisfactory (70% in 2010).

Registered Community designs continue to be a notable success story, with OHIM’s handling of applications rated as very good by 18% of respondents; the rest placed it in the good (55%) or satisfactory (27%) category. At present, three-quarters of respondents filed between 90% and 100% of their registered Community designs through the e-filing system, with none filing less than 70% of applications this way.

A new view

Turning to the tools offered by the agency, the TMview trademark database celebrated its first anniversary on April 13 2011. In the preceding 12 months it received 230,000 visits from 150 countries.

The current roster of trademark application and registration data available on TMview comprises information from OHIM and WIPO, as well as the Benelux, Bulgarian, Czech, Danish, Estonian, French, Italian, Portuguese, Slovakian, Slovenian, Spanish and UK offices. One of the higher-profile Cooperation Fund projects, TMview chimes with the stated goal of convergence, the aim being to create a unified database of trademarks.

A significant majority of filers polled had used the system (84%), and the merit of the offering was clearly seen. The main complaint concerned its incompleteness, with users stating that it is a useful tool, but not yet in a position to replace commercial systems and existing search services.

But these comments suggest that the desire is there to embrace the system once it has become more comprehensive – something that Campinos explains is under development: “Our first priority is to bring all EU member states into TMview. We have 14 offices, including OHIM and WIPO, at present and almost 6 million trademarks, with France the latest to join. Negotiations with a number of other offices interested in joining TMview later this year are at an advanced stage, with Romania, Germany, Greece, Ireland, Lithuania, Malta, Poland and Sweden all indicating that they want to take part. The level of interest is evidence of TMview’s growing usefulness as a user-friendly pre-screening tool and it is proving more and more popular.

“Offices outside of the EU are also expressing interest and we are willing to expand TMview’s scope. However, WIPO has a strategic interest in this kind of global expansion and we have signed a memorandum of understanding with them covering this and other cooperation. Eventually, the project could expand to include other international offices. Russia, Norway, Switzerland and Korea have expressed interest, and OHIM’s trilateral partners, the US Patent and Trademark Office and the Japan Patent Office, have agreed to do a feasibility study on the practicality of adding their trademark data, turning the project into a truly global tool.”

While TMview is arguably the best-known Cooperation Fund project, as mentioned earlier it is by no means the only one and progress continues on the development of new systems.

Graulund reports: “We had a report from the chairman of the management board of the fund in July and it is all progressing well. It is very open and transparent – we don’t have all the specific details about each project, but we don’t need them. We know that solid, professional people are working on it and I know we can pick up the phone if we do have any questions. So we are feeling quite confident about it.”

What is clear is that users have embraced the technologies that are offered to them. Turning to the e-filing systems, 84% of respondents stated that they filed between 90% and 100% of applications this way.

Commenting on the system, there was general consensus that the package has improved over time, providing an intuitive interface. Any gripes mainly related to compatibility with different IT environments and occasional difficulties when trying to upload images. As with any IT system, perfection can never be assured, but overall users feel that OHIM’s e-filing offering is one that fulfils an important need.

Interestingly, the e-opposition procedure is less utilised by the agents that WTR polled. One-quarter used the system for all oppositions, with another quarter using it frequently. However, 17% used it infrequently and one-third never.

While it has been a hectic first 12 months for Campinos, the next 12 are likely to be busier still. Graulund predicts that, in addition to any external requirements stemming from the European Commission, he will have to contend with several pressing issues: “The first is bringing down opposition decision times – this is the one element remaining from previous efforts to reduce the backlog. Improvement of quality is also important, and these two areas shouldn’t be forgotten in all the new things that have come up. You then have the Cooperation Fund projects continuing and the newly launched convergence programme. This then brings us to the strategic plan in general, and how this will be worked on over the next year.” [WTR](#)

Trevor Little, *World Trademark Review*